

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-10 and 29-38 were pending. Claims 1-10 and 29-38 were rejected. Claim 10 is hereby canceled. Claim 30 is amended. Claims 39-41 are added.

CLAIM OBJECTIONS

Claims 30-35 were objected to as being of improper dependent form. Claim 30 has been amended to remove the closed language, and to delete redundant elements. Withdrawal of the claim objections is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

Claims 30-32 and 34 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite because claim 30 included closed language, but claims 31, 32 and 34 added further elements. Claim 30 is amended to remove the closed language. Withdrawal of the rejection under § 112 is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-9 and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Horner, Jr. et al. This rejection is respectfully traversed.

The action states, "preferably, the coating mixture does not penetrate through the mat [0024]." However, the cited paragraph does not indicate that penetration is permitted, much less preferable. Paragraph [0024] states, "Advantageously, the consistency of the foam is such that the coating mixture **does not penetrate** through the mat and ideally simulates the consistency of shaving cream." [emphasis added]. The only sentence in Horner, Jr. et al. that mentions the

Appl. No. 09/241,450
Amdt. dated March 29, 2005
Reply to Office action of January 12, 2005

possibility of any penetration is in paragraph [0027], but this subject matter in paragraph [0027] **is not prior art** with respect to the present application.¹

The present application was filed on February 2, 1999, and thus predates the filing date of Application Nos. 10/117,912 and 09/376,247 by Horner, Jr. et al. Only Horner, Jr.'s provisional patent application 60/099451, dated September 8, 1998 (copy enclosed) predates the filing date of the current application. However, there is a significant difference between the disclosures of Horner, Jr.'s provisional application and his later-filed non-provisional applications. The only mention of penetration in the provisional application dated September 8, 1998 states, "The consistency of the foam is self-sustaining so that **it does not penetrate** through the mat and is ideally close to the consistency of shaving cream." Therefore, the mention in Horner, Jr.'s later non-provisional application regarding "reduced penetration of the coating mixture into the mat" is not entitled to the priority date (or § 102(e) date) of Horner, Jr.'s provisional application, and is not prior art with respect to the present application.

Thus, the patent and trademark office cannot apply Horner, Jr. as prior art for its suggestion of "reduced penetration of the coating mixture into the mat," because the effective filing date of Horner, Jr. for this teaching is August 18, 1999 (the actual filing date of parent application 09/376,247, which first included this language). The § 102(e) date for Horner, Jr. for this teaching is August 18, 1999, which is six months after Applicants' actual filing date.

The only teaching which which Horner, Jr. can be applied as prior art under § 102(e) teaches that the coating does **not** penetrate the mat.

The action alleges (in the paragraph bridging pages 5 and 6) that, "it would have been obvious ... to have made the thickness of the cover layer be substantially uniform and to have permanently embedded the cover layer into the body layer ..." However, the action apparently

¹ Paragraph [0027] recites, "Additionally, where the foamed coating on the facer is dried and/or cured, the bonding strength between the uncoated fibers and the core material in the resulting product is enhanced due to **reduced penetration of the coating mixture into the mat by reason of its prefoamed state.**" [emphasis added]

Appl. No. 09/241,450
Amdt. dated March 29, 2005
Reply to Office action of January 12, 2005

was written without a comparison between Horner, Jr.'s provisional application and his later filed non-provisional applications. The Action alleges that "Preferably, the coating mixture does not penetrate through the mat." Any reasonable reading of Horner, Jr.'s provisional application makes clear that "the foam does not penetrate through the mat." The provisional application does not state any option or preference regarding penetration; it clearly states that the "foam does not penetrate through the mat." The only suggestion that Horner, Jr.'s provisional application teaches a "preference" for non-penetration (or an option for penetration) appears in the Office Action.

Thus, Horner, Jr. teaches away from the invention of claim 1. A reference that teaches the opposite of what is now claimed cannot reasonably be relied on to render that claim obvious.

Therefore, a prima facie case of obviousness has not been established with respect to claim 1. Claim 29 includes similar features and should be allowable for at least the same reasons as claim 1. The dependent claims all include the limitations of base claim 1 or 29, and are patentable for at least the same reasons.

Amended claim 37 and new claims 39-41 are directed to some specific examples that are further distinguishable from Horner, Jr. et al.

New claim 39 requires that the body layer comprises insulation batting. Horner, Jr.'s facer is not insulation batting. Horner, Jr.'s product is a facer that is bonded to a rigid board. Thus, Horner, Jr. is directed to a different type of product than claim 39. Support for claim 39 is provided at page 4, line 1.

Claim 37 is amended to require that the body layer has a density from about 1 to 4 pcf. Horner, Jr.'s body layer has a substantially higher density of 0.1 to 0.4 g/cc (6 to 24 pcf), which is suitable for rigid boards, but would not be used for batting as required by claims 39 and incorporated by reference in claim 37. Support for amended claim 37 is provided at page 7, line 14.

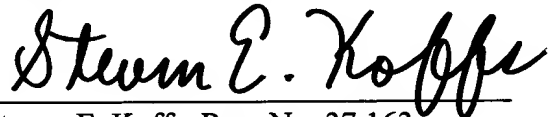
Appl. No. 09/241,450
Amdt. dated March 29, 2005
Reply to Office action of January 12, 2005

Claim 40 requires that the body layer have a thickness of about 0.5 to 6 inches. Horner, Jr. teaches a facer having a body layer of up to 30 mils, with a coating of up to 100 mils thereon, for a total of not more than 0.13 inch, which is a different product than claim 41. Support for claim 41 is provided at page 8, line 15. One of ordinary skill in the art would not be motivated by Horner, Jr. to make a facer 0.5 to 6 inches thick. Such a facer would not be practical to bond onto rigid insulation boards of the type described by Horner, Jr., having core thickness of 0.5 to 4 inches.

Claim 41 covers a product having the features of claims 37, 39 and 40. This combination defines an insulation batting product that is different in kind from Horner, Jr.'s facer. These properties are so different from the characteristics of Horner, Jr.'s facer, that claim 41 cannot remotely be characterized as optimizing Horner's product.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance, and request early notification to that effect.

Respectfully submitted,

A handwritten signature in black ink that reads "Steven E. Koffs". The signature is written in a cursive, flowing style with a horizontal line underneath the name.

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